

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Applicant(s): Nancy D. HANSON et al.

Serial No.: 09/814,257

Confirmation No.: 6204

Filed: 21 March 2001

For: PRIMERS FOR USE IN DETECTING BETA-LACTAMASES

Remarks

The final Office Action mailed 10 September 2002 has been received and reviewed. Claims 12-16 having been allowed, claims 17, 43, 49, and 51 having been amended, claims 45 and 46 having been cancelled, and claims 52-53 having been added, the pending claims are claims 12-17, 39-44, 47-49, and 51-53.

Claim 51 has been rewritten in independent form. Applicants assert, as indicated by the Examiner, that this claim is now allowable.

Claims 17 and 49 have been amended to recite primers specific for nucleic acid characteristic of OXA family beta lactamase enzymes excluding OXA-1, 10, 11, 14, 16 and 17. Claim 43 has been amended to recite primers specific for nucleic acid characteristic of OXA-5, 6, 7 and 13 beta lactamase enzymes. Applicants respectfully assert that by reciting a subgenus of the OXA family in these claims (e.g., by excluding the prior art), Applicants are not claiming new matter. Application of Johnson, 55 F.2d 1008, 1019 (1977) (Appendix B).

Claims 52 has been added to claim a method for identifying a beta-lactamase in a clinical sample including providing a pair of oligonucleotide primers wherein the primers are selected from the group of primers the Examiner has indicated are allowable. Support for this claim is found in the claims and in the specification at page 13, line 31 to page 15, line 17. Claim 53 have been added to claim a method for identifying a beta-lactamase in a clinical sample including matter analogous to that recited in claims 44 and 46, which the Examiner indicated would be allowable if rewritten in independent form.

Applicants assert that no new matter has been added as a result of these amendments.

Reconsideration and withdrawal of the rejections based on the above amendments and the following comments are respectfully requested.

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The 35 U.S.C. §102 Rejection

The Examiner rejected claims 17 and 43 under 35 U.S.C. §102(a) as being anticipated by Vahaboglu et al. (J. Clin. Microbiology, 36, 827-829, March 1998).

The Examiner rejected claims 17 and 45 under 35 U.S.C. §102(a) as being anticipated by Speldooren et al. (Antimicrobial Agents and Chemotherapy, 42, 879-884, April 1998).

The Examiner rejected claims 17 and 45 under 35 U.S.C. §102(a) as being anticipated by Siu et al. (APMIS, 106, 917-920, September 1998).

Claim 45, having been cancelled, renders the rejections to this claim moot. As to claim 17 and 43, Applicants respectfully traverse these rejections.

Claim 17 has been amended to recite a method for identifying a beta-lactamase in a sample that includes providing a pair of oligonucleotide primers specific for nucleic acid characteristic of the OXA family beta-lactamase enzymes excluding OXA-1, 10, 11, 14, 16, and 17. Claim 43 has been amended to recite the method of claim 17 wherein the primers are specific for nucleic acid characteristic of the OXA-5, 6, 7, and 13 beta-lactamase enzymes. Applicants respectfully submit that neither Vahaboglu et al., Speldooren et al., nor Siu et al. teach or suggest Applicants' claims 17, and 43, as amended. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejections.

The 35 U.S.C. §103 Rejection

The Examiner rejected claim 49 under 35 U.S.C. §103(a) as being unpatentable over Vahaboglu et al. (1998) as applied to claims 17 and 45 above, and further in view of Fluit et al. (WO 91/08305). Applicants respectfully traverse this rejection. Furthermore, Applicants respectfully point out that Vahaboglu et al. was not applied to claim 45 in a rejection under 35 U.S.C. §102, above. Claims 17 and 43 were rejected under 35 U.S.C. §102. Nonetheless, as

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indicated above, Applicants assert that none of the present claims, as amended, are anticipated by Vahaboglu et al.

Claim 49 has been amended to recite a diagnostic kit including providing a pair of oligonucleotide primers specific for nucleic acid characteristic of beta-lactamase enzymes of the same scope as recited in claim 17. As indicated above, Applicants respectfully assert that Vahaboglu et al. neither teach nor suggest Applicants' claims, as amended.

Additionally, Fluit et al., neither teach nor suggest the diagnostic kit as recited in claim 49, as amended. Therefore, Applicants submit that claim 49, as amended is patentable over Vahaboglu et al. in view of Fluit et al. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims Objected to as Being Dependent Upon a Rejected Base Claim

The Examiner objected to claims 39-42, 44, 46-48, and 50 as being dependent upon a rejected base claim, but indicated they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully submits that the claims from which these claims depend are allowable as amended. Applicant, therefore, respectfully requests reconsideration and withdrawal of the objection to claims 39-42, 44, 46-48, and 50.

Allowed Claims

Applicants thank the Examiner for allowing claims 12-16.

Summary

It is respectfully submitted that the pending claims 12-17, 39-44, 47-49, and 51-53 are in condition for allowance and notification to that effect is respectfully requested.

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The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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PATENT/TRADEMARK OFFICE

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 10th day of December, 2002, at 9:45 pm (Central Time).

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